

## R E M A R K S

Claims 30, 31, 36 and 37 are pending and stand rejected. The Examiner has made a number of rejections. The only remaining rejection is as follows:

- (1) Claims 30, 31, 36 and 37 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 5,316,931.

Applicants believe that the following remarks traverse the Examiner's rejection of the claims. These remarks are presented in the same order as they appear above.

### **I. THE CLAIMS ARE NOT ANTICIPATED**

#### **A. The Claims are not Anticipated by U.S. Patent 5,316,931**

The Examiner has rejected Claims 30, 31, 36 and 37 under 35 U.S.C. 102(e) as anticipated by U.S. Patent 5,316,931. The Applicants respectfully disagree. "[T]he rule is that the burden of persuasion is on the PTO to show why the applicant is not entitled to a patent." *In re Epstein*, 31 USPQ2d 1817, 1825 (Fed. Cir. 1994) (Plager, J. joined by Cowen, J., concurring.) (citing to *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992) (Plager, J., concurring); *In re Warner*, 379 F.2d 1011, 1016, 154 USPQ 173, 177 (CCPA 1967), *cert. denied*, 389 U.S. 1057(1968)). "[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability. If that burden is met, the burden of coming forward with evidence or argument shifts to the applicant . . . . If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent." *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

It is respectfully submitted that the Examiner has not satisfied the PTO burden. Specifically, the present application has a priority date of April 16, 1991. The '931 patent has a filing date of July 31, 1992. The Examiner has not shown that the '931 patent is entitled to an earlier priority date - this is particularly relevant since the July 31, 1992 filing was a *continuation-in-part*, which indicates that new matter was added. The Examiner has the burden in the first instance to show that the disclosure (now used as a basis for rejection) was in an earlier application in the lineage. Until the Examiner makes such a showing, there is no shifting of the burden to the applicant.

**CONCLUSION**

The Applicants believe that the arguments and claim amendments set forth above traverse the Examiner's rejections and, therefore, request that these grounds for rejection be withdrawn for the reasons set above. Should the Examiner believe that a telephone interview would aid in the prosecution of this application, the Applicants encourage the Examiner to call the undersigned collect at 617.252.3353.

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APPENDIX I  
CLEAN VERSION OF THE ENTIRE SET OF PENDING CLAIMS  
PURSUANT TO 37 CFR § 1.121 (c)(3)

The Following is a version of the claims pursuant to 37 C.F.R. § 1.121(c)(3) showing a clean version of the pending claims.

30. A method for producing plant virus particles comprising: a) providing i) plant viral nucleic acid comprising nucleic acid which codes for a coat protein, ii) a foreign nucleotide sequence coding for a foreign peptide; b) modifying said plant viral nucleic acid by inserting said foreign nucleotide sequence coding for a foreign peptide at a site within said plant viral nucleic acid which codes for the coat protein so as to create modified viral nucleic acid comprising an insert, wherein said site is free from direct sequence repeats flanking said insert; c) infecting plant material selected from the group consisting of plants, plant tissue, plant cells and protoplasts with said modified viral nucleic acid to produce assembled particles of a modified virus; and d) harvesting assembled particles of the modified virus from said plant material.

31. The method according to claim 30, in which the insert is an addition to said coat protein.

36. The method according to claim 30, in which the foreign nucleotide sequence is inserted by i) selecting two different restriction enzyme sites in the plant viral nucleic acid; ii) cutting the plant viral nucleic acid using the corresponding restriction enzymes; and iii) inserting into the cut viral nucleic acid a pair of complementary oligonucleotides which encode the foreign peptide and which terminate in ends compatible with the restriction enzyme cutting sites.

37. A method according to claim 36, in which in the complementary oligonucleotides, the sequence encoding the foreign peptide is flanked by plant virus-specific sequences so that the foreign nucleotide sequence is inserted as an addition to the plant viral nucleic acid.